

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office action, and amended as necessary to more clearly and particularly describe the subject matter which applicant regards as the invention.

A new title was required by the Examiner. The title of the application has been appropriately amended herein.

Claims 1-34 remain in this application.

Applicant's representative notes that, at the personal interview, various potential amendments to the claims were discussed. Applicant has not had time to consider these various proposed amendments in detail prior to the due date for filing this response, and thus does not provide any amendments herewith. However, applicant may file proposed amendments based on the results of the interview in the near future.

The Examiner provisionally rejected claim 1 under the judicially created doctrine of obviousness-type double patenting. The Examiner states that it would have been obvious to add the limitation that "a viewpoint represented by at least one keyword describing scenes" to application 09/467,231.

Applicant traverses this rejection. Claim 1 has been amended to clarify the claim, reciting that the "viewpoint" is included in the content description data. The Examiner has not provided any support for the motivation for adding the cited limitation. Clearly, the Examiner has obtained the motivation from the application itself, which is improper hindsight motivation.

Furthermore, because neither application has matured into a patent, the rejection must be held into abeyance until one of the applications does so mature (and, of course, the rejection could not apply to the first application to mature into a patent). Thus, the rejection is improper, and should be withdrawn.

Claims 1, 3-9, 11-17, 19-27 and 29-36 were rejected under 35 U.S.C. §103(a) as being unpatentable over Mauldin *et al.* (U.S. 5,664,227) in view of Wilcox *et al.* ("Annotation and Segmentation for Multimedia Indexing and Retrieval"). Claims 2, 10, 18, and 28 were rejected as above

in further view of Ozsoyoglu *et al.* ("Automating the Assembly of Presentation from Multimedia Databases"). For the following reasons, the rejections are respectfully traversed.

It was discussed at the personal interview with the Examiner and her supervisor that the claims recite the context description data and the scores being input into the device or method according to the claims. As discussed at the interview, the references do not suggest *inputting* any content description data, as recited by the claim. Instead, the references, in combination, merely discuss internally calculating such scores.

In addition, as also discussed at the interview, the "score" of Wilcox is not the same as the "score" of the claims. Wilcox defines the score according to the formula found in the reference. In contrast, the score of the application is defined as "attribute information" of the media content that is input. Wilcox does not suggest that its scores are attributes of the media content. Instead, the scores are calculated according to a formula, and thus are not attributes. At most, the combination of references may be argued to teach calculating a score, which is not "input" to the device.

The Examiner cites Mauldin as teaching inputting the "content description data" of the claims. However, a review of the reference does not support the Examiner's interpretation. Mauldin does not suggest *inputting* any data including a "score" and a "viewpoint" as recited in the claims. Instead, the Examiner is referring to the input of video data, which is not content description data. Wilcox, and the other references, do not overcome this Mauldin shortcoming. Thus, claims 1, 9, 17, and 27, are patentable over the references. The remaining claims, which depend, directly or indirectly, upon one of claims 1, 9, 17, and 27, are patentable over the references for at least the same reasons.

Furthermore, claim 1 also recites "selection means" for selecting one of said plurality of segments based on a viewpoint and/or a score. Claims 17, also recites such selection means. Claims 9 and 27 recite a step of selecting one of said plurality of segments based on a viewpoint and/or a score. The Examiner cites Wilcox as teaching such a limitation. However, the cited section of Wilcox appears to teach only the "listing of segments ordered by their scores" (see Examiner cited section). The reference does not suggest any selecting of such segments.

The remaining claims, which depend, directly or indirectly, upon one of claims 1, 9, 17, and 27, and patentable over the references for at least the same reasons.

Finally, the Examiner has not provided the proper motivation for combining the references. The burden is on the Examiner to make a prima facie case of obviousness (MPEP §2142). To support a prima facie case of obviousness, the Examiner must show that there is some suggestion or motivation to modify the reference (MPEP §2143.01). The mere fact that references can be combined or modified, alone, is not sufficient to establish prima facie obviousness (Id.). The prior art must also suggest the desirability of the combination (Id.). The fact that the claimed invention is within the capabilities of one of ordinary skill in the art is not sufficient, by itself, to establish prima facie obviousness (Id.).

Merely listing an advantage or benefit of the combination is not sufficient, as some rationale for combining the references must be found in the references themselves, or drawn from a convincing line of reasoning based on established scientific principles practiced by one skilled in the art that some advantage or beneficial result would be produced by the combination (MPEP §2144). Such motivation cannot be found in the application itself, as such hindsight is impermissible; the facts must be gleaned from the prior art. (MPEP §2142, last paragraph).

"To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made [and] the examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at that time to that person." (MPEP §2142, emphasis added). It is not proper to merely combine various elements from various references. The invention must be obvious "as a whole", not as a piecemeal combination of elements from various references.

In this case, the Examiner has merely cited an advantage of the secondary references as motivation. Such motivation is conclusory, and not legally sufficient. Accordingly, the rejection for obviousness is not supported by the Office action and thus the rejection is improper, and should be withdrawn.

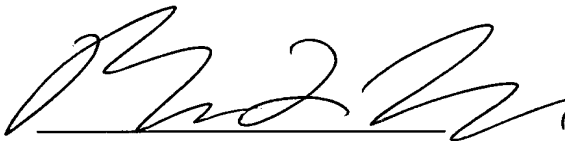
Appl. No. 10/733,981
Amdt. Dated March 22, 2005
Reply to Office action of September 22, 2004

It is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. 32161.

Respectfully submitted,

PEARNE & GORDON LLP

By: 
Robert F. Bodi, Reg. No. 48540

1801 East 9th Street
Suite 1200
Cleveland, Ohio 44114-3108
(216) 579-1700

Date: March 22, 2005